



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,802	03/27/2001	Tetsuya Noguchi	JP920000026US1	9893

48233 7590 07/23/2010
SCULLY, SCOTT, MURPHY & PRESSER, P.C.
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER

NGUYEN, MINH DIEU T

ART UNIT	PAPER NUMBER
----------	--------------

2438

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

07/23/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IBMPAIRENotify@ssmp.com

Office Action Summary	Application No. 09/818,802	Applicant(s) NOGUCHI ET AL.	
	Examiner MINH DIEU NGUYEN	Art Unit 2438	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, 14-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/24/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the communication dated 5/26/2009.
2. Claims 1-3, 5-12, and 14-24 are pending. Claims 4 and 13 are cancelled.

Drawings

3. The objection of the drawings has been withdrawn based on the filed amendment dated 5/26/2009.

Response to Arguments

4. Applicant's arguments with respect to claims 1-3, 5-12 and 14-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. Claims 20-24 are objected to because of the following informalities:
 - a) As to claim 20, "A storage medium" should be --A computer readable storage medium-- according to the spec [0122] of the instant Patent Application Publication.
 - b) As to claims 21-24, "a computer usable medium" should be --a computer readable storage medium--.
- Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 10, 16, 18, 20 recite the limitation "said proof" in "generating a certificate includes time information for said proof". Claim 5 recites the limitation "said signature step" and claim 14 recites the limitation "said signature means". There are insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 5-12, 14-15, 18-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaeth et al. (6,308,277) in view of Kobata et al. (6,591,367) and further in view of DeBry (6,385,728).

a) As to claims 1, 10, 18, 20-22 and 24, Vaeth discloses a method and system for issuing and managing certificates in the field of telecommunications, particularly in electronic commerce (Vaeth: col. 1, lines 10-13) comprising the steps of a proof service provider transmitting a certificate generation request to a witness or a certificate generator (Vaeth: col. 6, lines 19-20); and generating a certificate (Vaeth: col. 6, line 21).

Vaeth does not disclose the step of the witness or certificate generator obtaining electronic content upon the receipt of the certificate generation request from the service provider.

Kobata discloses a method and apparatus for transmitting digital information over a network (Kobata: col. 1, lines 1-2) comprising receiving system obtains digital information from a server system (Kobata: Fig. 1; col. 3, lines 21-43; col. 4, lines 6-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of obtaining contents electronically as Kobata teaches in the system of Vaeth so as to save transmission bandwidth.

The combination of Vaeth and Kobata is silent on the teaching of including address information for said electronic content and time information for said proof in the certificate.

DeBry is relied on for the teaching of including address information for said electronic content and time information for said proof in the certificate (DeBry: Fig. 2, elements 42 and 44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of including address information for said electronic content and time information for said proof in the certificate in the system of Vaeth and Kobata, as DeBry teaches so as to securely retrieve a file.

b) As to claims 2, 7 and 11, the combination of Vaeth, Kobata and DeBry discloses the certificate includes the electronic content or data which is a hash code that uniquely represents the electronic content (Vaeth: Fig.1, col. 3, lines 35-41).

c) As to claims 3 and 12, the combination of Vaeth, Kobata and DeBry discloses the method further comprising the step of accumulating the certificate in the service provider or transmitting the certificate to a user (Vaeth: col. 8, lines 49-51).

d) As to claims 5, 14 and 19, the combination of Vaeth, Kobata and DeBry discloses the step of generating the certificate includes a step of providing a signature for the certificate and wherein the signature step includes a first configuration process consisting of a first signature step by the witness or the certificate generator and a second signature step by the service provider (Vaeth: col. 4, lines 43-47) or a second configuration process consisting of a signature step by a notary service provider.

e) As to claims 6 and 15, the combination of Vaeth, Kobata and DeBry discloses the signature is encrypted using a public key encryption method to prevent alteration by a person other than a signer (Vaeth: col. 2, lines 16-67; col. 3, lines 1-13; lines 35-40).

f) As to claim 8, the combination of Vaeth, Kobata and DeBry discloses the method wherein in accordance with a request from the user, the certificate generation request is transmitted to the witness or the certificate generator on one or multiple dates or is transmitted continuously during one or multiple specific periods (Vaeth: col. 6, lines 1-6).

g) As to claim 9, the combination of Vaeth, Kobata and DeBry discloses the method wherein synchronization of time is effected between the service provider and the witness or the certificate generator (Vaeth: Fig. 2, elements 80 and 90).

Art Unit: 2438

10. Claims 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaeth et al. (6,308,277) in view of Lim (6,728,884) and further in view of DeBry (6,385,728).

Vaeth discloses a method and system for issuing and managing certificates in the field of telecommunications, particularly in electronic commerce (col. 1, lines 10-13) comprising means for accepting and for analyzing a service request received from a user (Fig. 2, element 75); means for transmitting a certificate generation request to the witness or the certificate generator that is selected (Fig. 2, element 81); means for accepting a certificate from the witness or from the certificate generator (Fig. 2, element 83); means for transmitting the certificate to the user (Fig. 2, element 77).

Vaeth does not disclose means for selecting a witness or a certificate generator from a registered member group.

Lim discloses a method and apparatus for selectively authenticating and authorizing a client seeking access to one or more protected computer systems over a network comprising means for selecting a name that corresponds to a proxy server from the plurality of proxy servers to authenticate user (col. 9, lines 58-67 to col. 10, lines 1-5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of selecting a certificate generator or witness i.e proxy server from a plurality of proxy servers as Lim teaches in the system of Vaeth so as to guarantee the randomness and fairness in authenticating and authorizing users.

The combination of Vaeth and Lim is silent on the teaching of including address information for said electronic content and time information for said proof in the certificate.

DeBry is relied on for the teaching of including address information for said electronic content and time information for said proof in the certificate (DeBry: Fig. 2, elements 42 and 44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of including address information for said electronic content and time information for said proof in the certificate in the system of Vaeth and Lim, as DeBry teaches so as to securely retrieve a file.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vaeth et al. (6,308,277) in view of Lim (6,728,884) in view of DeBry (6,385,728) and further in view of Kohl et al. (6,430,688).

Vaeth further discloses means for accepting the certificate, however Vaeth, Lim and DeBry do not include means for providing an electronic signature to the certificate.

Kohl discloses a method, apparatus, article of manufacture and a memory structure for issuing digital certificates to a client comprising digital signatures incorporate into a certificate (col. 5, lines 37-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of incorporating digital signatures into a certificate as Kohl teaches in the system of Vaeth, Lim and DeBry so as to ensure the authenticity.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi T. Arani can be reached on 571-272-3787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Minh Dieu Nguyen/
Primary Examiner, Art Unit 2438